

REMARKS/ARGUMENTS

Upon entry of this amendment, claims 1, 3-6, 9, 12, 13, and 15-19 are pending in this application and presented for examination. Claims 2, 7, 8, 10, 11, and 14 have been canceled without prejudice. Claims 9, 12, 13, and 15 have been allowed. Claims 1, 3, 6, 16, 18, and 19 have been amended. No new matter has been introduced with the foregoing amendments. Reconsideration is respectfully requested.

I. FORMALITIES

Claim 3 has been amended to correct a typographical error. Support for amended claims 1, 6, 16, 18, and 19 is found, for example, on page 12, lines 3-6. Thus, no new matter has been introduced, and Applicants respectfully request that the amendments be entered.

II. SPECIFICATION

Applicants submit concurrently herewith in a separate paper both a paper copy and a computer readable copy of the Sequence Listing. As such, Applicants respectfully request entry of the Sequence Listing in adherence with 37 C.F.R. §§ 1.821-1.825.

III. ABSTRACT

Applicants submit herewith an abstract of the disclosure on an attached separate sheet. Applicants assert that this abstract is identical to the abstract on the front page of the application as filed, which corresponds to the abstract from PCT Publication No. WO 99/02719. No new matter has been introduced. As such, Applicants respectfully request that the abstract be entered.

IV. DECLARATION

The Examiner alleges that the executed Declaration is defective as it fails to indicate that the specification as amended on August 23, 1999 had been "reviewed and understood" by the inventors. Applicants submit herewith an unsigned Substitute Declaration, included herein as an attachment. On the new Declaration, Applicants have indicated that the

original application was amended on April 19, 1999, and that the specification, including the claims, as amended has been reviewed and understood by the inventors. The Examiner will be provided with an executed copy of the new Declaration once it is received by the undersigned.

V. REJECTION UNDER 35 U.S.C. § 112, FIRST PARAGRAPH

Claims 1, 3-6, and 16-19 were rejected under 35 U.S.C. § 112, first paragraph, as allegedly containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. To the extent the rejection is applicable to the amended set of claims, Applicants respectfully traverse the rejection.

The Examiner alleges that "while the method steps will necessarily lead to the detection of genes that are expressed in the same cell type in which the chosen tissue specific promoter is active, these genes need not also be expressed in a tissue restricted manner as required by the claims." In order to expedite prosecution, Applicants have amended claims 1, 16, 18, and 19 to recite methods wherein the target gene is expressed in the same cell or tissue type in which the chosen cell- or tissue-specific promoter is active. During a telephonic interview with the Examiner on December 19, 2003, the Examiner indicated that such amendment to the claims may be sufficient to overcome the 35 U.S.C. § 112, first paragraph, rejection. As such, Applicants respectfully request that the Examiner withdraw the 35 U.S.C. § 112, first paragraph, rejection.

CONCLUSION

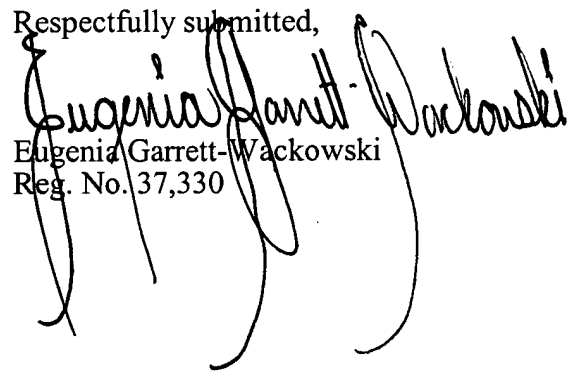
In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

Appl. No. 09/295,464
Amdt. dated December 23, 2003
Reply to Office Action of June 27, 2003

PATENT

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 925-472-5000.

Respectfully submitted,


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Attachments
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